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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,810	03/15/2004	Joseph Raymond Faryniarz	J6832(C)	1604

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/800,810

Applicant(s)

FARYNIARZ ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/14/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Zimmerle (US 5350694).

Zimmerle discloses tris(hydroxyethyl)aminomethane-malonic acid (Tris-malonate). See col. 13, lines 42-43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over as Paniccia (Poucher's Perfumes, Cosmetics and Soaps, 2000) and Jokura et al. (US 5,641,495).

Paniccia teaches a method of shaving hair by applying shaving lather cream directly onto an area of skin to form a dispersed layer of the shaving preparation, followed by shaving the area with a razor. See col. 1, lines 56 – 61; instant claims 1 and 6. The reference teaches a formulation which comprises glycerol, which is a moisturizer. See p. 351, Formula I. The reference also teaches post-foaming gel which forms a dense creamy foam which conveys rich moisturizing properties. See p. 353. The reference also teaches that a skilled artisan would have been concerned with skin irritation and inflammation caused by in-grown hair and shaving process. See p. 348, bridging par.

While Paniccia indicates that the shaving preparations require skin-conditioning agents, such as moisturizing agents, the reference does not specifically teach using malonic acid or its salts.

Jokura teach the use of the amine salts of malonic acid in cosmetically acceptable vehicles. See col. 3, lines 31 – 50. Alkanolamines such as triethanolamine salts and ammonium salts are taught. See instant claims 1, 3, 4. The reference teaches that the malonic acid salts moisturize the skin without irritation. The reference teaches the application of the moisturizing agent in emulsion or gel form which is thereby formulated to lotion or cream. See col. 3, lines 66 – col. 4, line 4. The

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reference teaches that to achieve a satisfactory moisturizing effect without irritation, 0.01-10 % by weight of the acid or salt is used. See col. 3, lines 51 – 36. Using water, ethanol, and/or water-soluble polyhydric alcohols are used in the amount of 0.01-95 % by weight of the total composition. See col. 4, lines 29 – 34.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the shaving preparations of Paniccia by incorporating malonic acid salts, as motivated by Jokura, because 1) Paniccia teaches adding skin conditioning agents to the shaving preparation, which particularly is designed for areas of skin which is prone to skin irritation; and 2) Jokura teaches that the salts of malonic acids, such as triethanolamine or ammonium salts of malonic acid, are non-irritating and moisturizes the skin. The skilled artisan would have had a reasonable expectation of successfully making cream or gel preparations comprising the amine salts of malonic acid, because Jokura teaches that the salts of malonic acids can be used in emulsions, gels, and cream.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over as Paniccia and Jokura et al., as applied to claims 1, 3, and 4 as above, and further in view of Flick (Cosmetic and Toiletry Formulations, 1996).

While Jokura teaches alkanolamine salts of malonic acid and other dicarboxylic acids, the reference does not specifically teach trishydroxymethylaminomethane salts.

Flick teaches that tris(hydroxymethyl)aminomethane is an old and well known buffering agent in cosmetic art. The reference teaches an aftershave gel formulations which contains neutralized product of carbomer 980 (polyacrylic acid) with Tris Amino.

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See p. 508, Aftershave gel. Tris amino is tris(hydroxymethyl)aminomethane. See p.543, Sun protection gel.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to further modify the shaving preparation of the combine references by using the salts of tris(hydroxymethyl)aminomethane and dicarboxylic acids, as motivated Flick, because 1) Paniccia teaches making non-irritating shaving preparations using moisturizing agents; 2) Jokura teaches using alkanolamine salts of dicarboxylic acids as non-irritating moisturizing agent in cosmetic compositions; and 3) Flick teaches that trishydroxymethylaminomethane, an alkanolamine, is conventionally used in shaving preparations as a neutralizing agent. The skilled artisan would have had a reasonable expectation of successfully producing a stable and non-irritating shaving composition containing the trishydroxymethylaminomethane salt of the dicarboxylic acids.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/767679.

Claim 1 of the '679 application is directed to a personal care composition comprising 0.000-30 % by weight of the composition of a salt of malonic acid in 1-99 % by weight of the composition of a cosmetically acceptable carrier. The term "personal care composition" encompasses shaving preparation, as defined in specification, p. 5, [0016]. The salt of ammonium, tris(hydroxymethyl)amino methane, and triethanolamine of malonic acids are taught in the copending claims 4 and 5. See instant claims 2-6. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed method is an obvious use of the personal care composition of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Paniccia (Poucher's Perfume, Cosmetics and Soaps, 2000) and claims 1, 3-16 of copending Application No. 10/601731.

Paniccia, as discussed above, teaches a method of shaving by topically applying a composition comprising skin conditioning agents to the area of skin where

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the hair is to be removed prior to shaving with razor. The reference fails to teach salt of malonic acid.

While Paniccia indicates that the shaving preparations require skin-conditioning agents, such as moisturizing agents, the reference does not specifically teach using malonic acid or its salts.

Claim 1 of the '731 application is directed to a cosmetic composition comprising 0.001-30 % by weight of a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 % by weight of a cosmetically acceptable. Claims 4-5 teach Tris(hydroxymethyl)methylammonium malonate, ammonium malonate, triethanolammonium malonate. Claims 6-7 also teach that the composition is effective in "significant activity in improving the softness, suppleness and flexibility of skin" and effective in "combating the signs of skin aging".

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the shaving preparation of Paniccia by incorporating malonic acid salts, as motivated by teaching of the copending application because 1) Paniccia teaches adding skin conditioning agents to the shaving preparation; and 2) '731 claims the use of the salts of malonic acids, such as triethanolamine salts of malonic acid, are non-irritating and moisturize the skin and improve the softness, suppleness and flexibility of skin.

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/601856.

Claim 1 of the '856 is directed to a cosmetic composition comprising 0.001-30 % by weight of a mono-hydroxy substituted amine salt of malonic acid and 1-99.9 % by weight of a cosmetically acceptable. Tris(hydroxymethyl)methylammonium malonate, ammonium malonate, triethanolammonium malonate are disclosed, meeting instant claims 2-6.

Although the copending claims do not recite a "method of in-grown hair" by applying the composition after-shave, examiner views that a topical application of a cosmetic composition after a shaving procedure is an obvious use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1, 3, and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/374300.

Claim 1 of copending application '300 is directed to a cosmetic composition comprising 0.0001-30 % of amine salt, including ammonia and triethanolamine, of malonic acid in a cosmetically acceptable carrier. See also, specification, [00011].

Although the copending claims do not recite a "method of in-grown hair" by applying the composition after-shave, examiner views that a topical application of a cosmetic composition after a shaving procedure is an obvious use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gina C. Yu
Patent Examiner